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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/783,059      | 02/14/2001  | Tapani Ryhanen       | 297-010113-US(PAR)  | 9629             |

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PERMAN & GREEN  
425 POST ROAD  
FAIRFIELD, CT 06824

EXAMINER

HAM, SEUNGSOOK

ART UNIT PAPER NUMBER

2817

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/783,059

Applicant(s)

RYHANEN ET AL.

Examiner

Seungsook Ham

Art Unit

2817

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,3,7-24,27-32 and 43-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,18,19,21,22,43,44,48,51 and 52 is/are allowed.
- 6) ☒ Claim(s) 2, 7-17, 20, 23-32, 45-47, 49, 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 601, 602, 603, 605 (see claim 45) and 610 (see claim 47). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claims 45 and 46 (including the numerals, 601-604, 610 in conjunction with numerals 3, 7, 8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

page 18 should be deleted since the references are cited in PTO-1449;

page 2, lines 1 and 2 should be deleted;

page 7, line 26, "third" should be corrected to --six--; and

In page 15, line 15, "first dielectric insulating layer 7", and page 16, line 2, "second dielectric layer 7", the numeral "7" defines two different elements.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 7-17, 20, 22, 23, 28-30, 45, 46, 47, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, "a substrate insulating layer" is confusing as to how this layer is related to "a substrate insulating layer" recited in claim 43.

The subject matter of claim 7 is already included in claim 43.

In claim 8, "the gap" lacks antecedent basis.

In claim 9, "the air gap" lacks the antecedent basis.

Claim 10 and 11 are dependent on a cancelled claim.

In claims 12 and 13, "the capacitor electrode" is confusing as to whether it refers to a first capacitor electrode or second capacitor electrode as recited in claim 43.

In claim 15, "the conducting layer" is confusing as which conducting layer refers to (e.g., first, second or third, see claim 43); and "the capacitor and/or the second capacitor electrode" is vague and indefinite since the second capacitor electrode is a part of the capacitor.

Claims 16 and 17 contain improper Markush group (see MPEP 2173.05(h)), and the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

In claim 20, "the conducting layer" is confusing as which conducting layer refers to (e.g., first, second or third, see claim 43).

In claim 23, "the segments" lacks antecedent basis (appears to be dependent on claim 22 rather than claim 43), "the same fabrication process with capacitors and inductors" cannot be understood (examiner suggests to delete).

In claim 28, "said second capacitor electrode" lacks antecedent basis.

In claim 29, "the second capacitor electrode" lacks antecedent basis.

Claim 30 is dependent on a cancelled claim.

Claim 45 is vague and indefinite as to how first capacitor plate, second capacitor plate, a first capacitor plate, are related to each to form a capacitor. Moreover, it is unclear as to how the newly added limitation, lines 14-17 is related to the other elements recited in the claim. Furthermore, "said first capacitor electrode" (said at least one active electrode?, see fig. 3a) lacks antecedent basis.

In claim 46, "clamped points and/or sides" cannot be understood.

In claim 47, "the dielectric gap" lacks antecedent basis.

***Allowable Subject Matter***

Claims 43, 3, 18, 19, 21, 22, 44, 48, 51 and 52 are allowed.

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The following is a statement of reasons for the indication of allowable subject matter: Prior art does not show "wherein said substrate is removed up to said first capacitor electrode or up to said substrate insulating layer" as recited in claim 43, lines 22-27.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seungsook Ham whose telephone number is (703) 308-4090. The examiner can normally be reached on Monday - Thursday from 8:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Pascal can be reached on (703)308-4909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Seungsook Ham  
Primary Examiner  
Art Unit 2817

sh  
May 21, 2003